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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Nisson *et al.*

Appl. No. 09/829,066

Filed: April 10, 2001

For: **Method for Isolating and Recovering Target DNA and RNA Molecules Having a Desired Nucleotide Sequence**

Confirmation No. 1532

Art Unit: 1656

Examiner: Lu, F.

Atty. Docket: 0942.4800002/RWE/ALS

Reply To Restriction Requirement

Commissioner for Patents
Washington, D.C. 20231

Sir:

In reply to the Office Action dated **April 25, 2002**, requesting an election of one invention to prosecute in the above-referenced patent application, Applicants hereby provisionally elect to prosecute the invention of Group I, represented by claims 1-4, 6-8 and 41. Consonant with this requirement, Applicants also elect the following species:

i) one or more amino acid denaturants, upon which claims 1-4, 6-8 and 41 read thereon; and

ii) polyamino acids, upon which claims 2-4 and 41 read thereon.

As the Examiner has not identified the species under paragraphs 6 or 7 as corresponding to any claims of Group I (see PTO File Wrapper Paper No. 13, pp. 5-7), it is not believed that an election of any of these species is necessary. However, to the extent that the Examiner partially or entirely withdraws the restriction requirement thus requiring an election of species described under paragraphs 6 or 7, Applicants hereby elect the following species:

iii) cDNA library, upon which claim 14 reads thereon; and

iv) circular DNA, upon which claim 11 reads thereon.

This election is made without prejudice to or disclaimer of the other claims or inventions disclosed.

Traversal of the Restriction Requirement

This election is made **with** traverse. The criteria for a proper requirement for restriction are that (1) the inventions must be independent or distinct as claimed; *and* (2) there must be a serious burden on the Examiner if restriction is not required. MPEP § 803 (emphasis added). It should be noted that the two requirements set forth in MPEP § 803 are connected with "and." Hence, satisfaction of both criteria is required.

Applicants respectfully assert that the Examiner has not satisfied the second criteria. Groups I-III are closely related in subject matter. As such, a search of one group of claims is likely to encompass subject matter pertinent to the patentability of all groups. Moreover, groups I and II have been classified by the Examiner in class 436, subclass 94. The Examiner has also not shown by appropriate explanation any of the three reasons supporting a serious burden if restriction were not required, as set forth in MPEP § 808.02. A serious burden therefore has not been established, and "[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions." MPEP § 803. Hence, reconsideration and withdrawal of the Restriction Requirement is respectfully requested.

Traverssal of Election of Species Requirement

Applicants respectfully remind the Examiner that a reasonable number of species may be claimed in different claims in a single application, provided the application includes a claim generic to all the claimed species and the claims drawn to alleged species are dependent from the generic claim(s). See 37 C.F.R. § 1.141(a). Moreover, when inventions

are (a) species under a claimed genus and (b) related, then the question of whether or not an election of species requirement is proper must be addressed using the criteria for determining whether or not a restriction requirement is proper; if restriction is improper under the facts of the case, an election of species requirement should not be made. See MPEP § 806.04(b).

In the present case, the alleged species identified by the Examiner in paragraphs 5, 6 and 7 of the Restriction Requirement (see PTO File Wrapper Paper No. 13, pp. 4-7) are all related and they all ultimately depend from one or more of claims 1, 9 or 42, which have all been identified by the Examiner as being generic. *See Id.* Therefore, both requirements under 37 C.F.R. § 1.141(a) are met, and it must be determined whether or not restriction would be proper in the present case to determine the propriety of the election of species requirement.

As noted above, the criteria for a proper restriction are that (1) the inventions must be independent or distinct as claimed; and (2) there must be a serious burden on the Examiner if restriction is not required. MPEP § 803. Applicants respectfully assert that the Examiner has not satisfied the second criteria. The three groups of species identified by the Examiner in paragraphs 5, 6 and 7 of the Restriction Requirement respectively contain members that are closely related in subject matter. As such, a search of one of these alleged species is likely to encompass subject matter pertinent to the patentability of all members, particularly since the points of novelty of each member lies primarily in one of claims 1, 9 or 42 from which it depends. Moreover, the Examiner has not shown by appropriate explanation any of the three reasons supporting a serious burden if restriction were not required, as set forth in MPEP § 808.02. A serious burden therefore has not been

established, and "[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions." MPEP § 803.

Hence, since a restriction requirement would not be proper under the facts of the present case, Applicants respectfully assert that the Election of Species requirement is improper as well under 37 C.F.R. § 1.141 and MPEP 806.04(b). Therefore, reconsideration and withdrawal of the Election of Species requirement, and consideration of all pending claims, are respectfully requested.

It is not believed that extensions of time are required, beyond those that may otherwise be provided for in accompanying documents. However, if additional extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor are hereby authorized to be charged to our Deposit Account No. 19-0036.

Respectfully submitted,

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